

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

50990036-2 US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on August 22, 2005

Signature

Typed or printed
name

Mia Kim

Application Number

09/765,067

Filed

January 18, 2001

First Named Inventor

Gavin BREBNER

Art Unit

2154

Examiner

Dustin NGUYEN

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐

attorney or agent of record.

Registration number

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

43,010

Signature

ROBERT POPA

Typed or printed name

(323) 934-2300

Telephone number

August 22, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐*Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

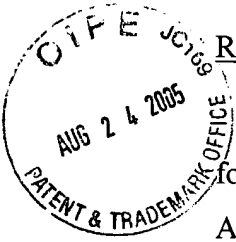
Rejection under 35 U.S.C §112

Claims 2, 11-15, and 17 stand rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner asserts that the term “said profile” in claim 2 lacks antecedent basis. In reply to Applicant’s argument that claim 2 is dependent from claim 1, which recites “a local profile” and therefore provides sufficient antecedent basis for “said profile” in claim 2, the Examiner presently retorts that “the ‘said profile’ of claim 2 is *not as specific* as ‘local profile’ in claim 1” (paragraph 2 of the Final Action). Lack of antecedent basis is not based upon an Examiner’s subjectively perceived, relative specificity. “A claim is indefinite when it contains words or phrases whose meaning is unclear.” MPEP 2173.05(e). There can be no reasonable doubt that “said profile” in claim 2 refers to the “local profile” of claim 1. The Examiner’s unexplained desire for more specificity notwithstanding, there is ample antecedent basis for “said profile” in claim 2.

Rejection under 35 U.S.C §103

Claims 1-4, 6-15, 17-21, and 23-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,578,142 to Anderson et al. in view of U.S. Pat. No. 6,102,969 to Christianson.

Applicant has pointed out repeatedly that there is nothing in Christianson that may be understood as disclosing the receiving of an abstract request formulated at a client computer, that “abstract request” as used in the present claims and read in light of the specification (see, e.g., page 7, line 32 to page 8, line 2) refers to a request for a transaction that only contains “some basic incomplete information” or “only partial information” for completing the requested transaction, and that the claim language itself clearly sets forth that the abstract request contains “incomplete information identifying a potential transaction.” The Examiner presently replies that “Christianson discloses a process of receiving a query from a client computer [31, Figure 3; and col 7, lines 41-42], a netbot acts as a user’s intelligent assistant which assists user in finding needed



information from relevant information sources [col 4, lines 19-33], and the netbot doing so by adding additional information from the wrapper module to the query before forwarding to the information sources [col 8, lines 25-35; col 12, lines 2-20; and col 15, lines 19-65]" (paragraph 4 of the Final Action). The Examiner once again completely ignores Applicant's arguments and does not even allege that, much less cite to a specific portion of the specification where Christianson teaches receiving an abstract request that contains incomplete information identifying a potential transaction.

In reply to Applicant's argument that the Examiner has failed to allege where the cited art teaches "detecting a condition of insufficient resources" as recited in claim 10, the Examiner now asserts that "Anderson discloses detecting a condition of insufficient resources [i.e. detecting module for determining available bandwidth] [502, Figure 5; and col 12, lines 47-67]" (paragraph 6 of the Final Action). Applicant is forced to surmise that the Examiner is therefore alleging that a "detecting module for determining available bandwidth" teaches "detecting a condition of insufficient resources" but fails to discern any support for the Examiner's assertion. How is "determining available bandwidth" the same as "detecting a condition of insufficient resources?" How is "available bandwidth" the same as "insufficient resources?" The Examiner is clearly assigning *ad hoc* definitions to the claims terms with no regard whatsoever to their plain meaning or that set forth in the specification.

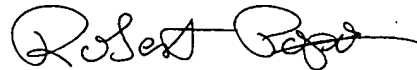
In reply to Applicant's argument that there is nothing in Warwick even remotely connected or connectable to a method of collecting data representative of a computer profile for achieving an electronic business transaction, the Examiner now alleges that "Warwick discloses the above limitation [i.e. querying for management information associated with devices and store in storage 209 [Figure 2; and col 2, lines 49-65] and the task can be performed in a distributed computing environment or remote computer [col 4, lines 1-7] (paragraph 8 of the Final Action). Applicant is once again forced to surmise that the Examiner is thus alleging that "querying for management information associated with devices and store in storage" is anticipatory of "collecting data representative of a computer profile for achieving an electronic business transaction" and once again fails to find any support offered by the Examiner to shore up this allegation. It is doubtful that

“querying for management information associated with devices and store in storage” is even an accurate summary of the cited paragraph; to bridge to the conclusion that it actually teaches “collecting data representative of a computer profile for achieving an electronic business transaction” will require very specific guidance from the Examiner.

In reply to Applicant’s argument that there is no support to be found in any of the references for the Examiner’s alleged motivation for the skilled person to combine Christianson, Anderson, and Warwick, the Examiner presently offers that “it would have been obvious to combine the references because the adding of DMI or WMI interfaces of Warwick would allow to determine the available resources and management application has a better knowledge of its hardware devices [Warwick, col 6, lines 27-33]” (paragraph 9 of the Final Action). Applicant cannot even begin to guess where the “DMI or WMI interfaces of Warwick” should be added to, much less why such adding would somehow anticipate any of the present claims, and is at a complete loss as to what “allow to determine the available resources and management application has a better knowledge of its hardware devices” is intended to mean. The Examiner’s cryptic assertions continue to fall well short of explaining exactly how the references are to be combined, why the skilled person reading any one of these references would feel compelled to consult any of the other references and, to the best that Applicant can understand it, is not in fact supported by the cited portion of the specification.

For all of the above reasons, Applicant respectfully submits that the Final Office Action mailed on May 26, 2005 contains multiple clear errors in the examiner's rejections and that the examiner's rejections omits essential elements required for a prima facie rejection. Applicant thus respectfully requests that the application be allowed on the existing claims and prosecution remain closed.

Respectfully submitted,



Robert Popa
Attorney for Applicant
Reg. No. 43,010
LADAS & PARRY
5670 Wilshire Boulevard, Suite 2100
Los Angeles, California 90036
(323) 934-2300 voice
(323) 934-0202 facsimile
rpopa@ladasparry.com